

Remarks/Arguments:

Claims 11-22, presented hereby, are pending.

Claims 1-10 are cancelled, hereby, without prejudice or disclaimer.

Present claim 11 contains the subject matter of claim 1 combined with features (limitations) from claim 6 – specifically, the RNA polymerase being from phage T7, the triphosphates of adenosine, uridine, cytidine, and guanosine triphosphate being present at a final concentration, together, of 2 to 3.5 mM, and the inosine triphosphate being present at a final concentration of 3.2 to 4.4 mM (which ribonucleoside triphosphate concentrations also are found in the working examples of the subject application). Present claims 12-20, which depend directly or indirectly on claim 11, contain subject matter of claims 3-10.

Present claim 21 corresponds to claim 4, written as an independent claim. Present claim 22 corresponds to claim 5, revised to be dependent on claim 21.

Claims 1-9 were rejected under 35 USC 112, 2nd ¶, as allegedly being indefinite. Reconsideration is requested in view of the changes to claim language effected by the instant amendment.

In analyzing the claims for compliance with §112, ¶2, it must be borne in mind that requiring some thought to understand the meaning of the claims does not render the claims indefinite under §112, ¶2. *S3 Inc. v. nVIDIA Corp.*, 59 USPQ2d 1745 (Fed. Cir. 2001).

The purpose of the claims is not to explain the technology or how it works, but to state the legal boundaries of the patent grant. A claim is not "indefinite" simply because it is hard to understand when viewed without benefit of the specification.

59 USPQ2d at 1748. While claims are to be given their broadest reasonable interpretation during prosecution, the definition of a claim limitation given by the PTO cannot be different than would be given by one of ordinary skill in the art. *In re Cortright*, 49 USPQ2d 1464 (Fed. Cir. 1999).

The statement of rejection raises 4 issues (a, b, c, and d) of allegedly indefinite claim language. With respect to instance (a), the present method claims recite "the basic steps . . . in a positive, active fashion," as required in the statement of rejection. As further required, the scope of the present claims is unambiguous. With respect to instances (b), (c), and (d), none of the present claims contains the terms "capable of" or "characterized in that" and none of the present claims contains any words in parentheses. Accordingly, the issues raised in the statement of rejection being resolved, withdrawal of the rejection under §112, 2nd ¶, appears to be in order.

Claims 1-3 and 6-10 were rejected under 35 USC 102(b), as allegedly anticipated by US5654142 (Kievits) or *Nucleic Acids Research*, 26, 1854-1855, 1998 (Nakahara), or under 35 USC 103(a) as being allegedly obvious over either Kievits or Nakahara in view of *Molecular Biology Labfax*, Bios Scientific Publishers, 1991, or over Kievets in view of US4582789 (Sheldon). Reconsideration of the rejections under §102(b) and §103(a) is requested.

For anticipation under § 102 to exist, each and every claim limitation, as arranged in the claim, must be found in a single prior art reference. *Jamesbury Corp. v. Litton Industrial Products, Inc.*, 225 USPQ 253 (Fed. Cir. 1985). The absence from a prior art reference of a single claim limitation negates anticipation. *Kolster Speedsteel A B v. Crucible Inc.*, 230 USPQ 81 (Fed. Cir. 1986). A reference that discloses "substantially the same invention" is not an anticipation.

Jamesbury Corp. To anticipate the claim, each claim limitation must "*identically* appear" in the reference disclosure. *Gechter v. Davidson*, 43 USPQ2d 1030, 1032 (Fed. Cir. 1997) (*emphasis added*). To be novelty defeating, a reference must put the public in possession of the identical invention claimed. *In re Donahue*, 226 USPQ 619 (Fed. Cir. 1985).

Kievits discloses that "Good results are obtained when no more than 50% of the GTP present in an amplification reaction mixture is substituted with ITP" and that the optimal ratio of ITP:GTP has been found to be approximately 1:3" (column 3, lines 27-30 and lines 36-37). Thus, Kievits teaches away from the presently claimed invention.

Nakahara discloses that "an increase in the yield of NASMA products was observed at . . . peaking at 1.5-2 mM" and that "The optimal ITP concentration was determined to be 2mM" (p. 1854, the right column, lines 6-9). Thus, Nakahara does not disclose the presently claimed invention.

Accordingly, withdrawal of the the rejections under 35 USC 102(b) appears to be in order.

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art," *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970), "and it is error to ignore specific limitations distinguishing over the [prior art] reference." *Ex parte Murphy*, 217 USPQ 479, 481 (PO Bd. App. 1982). A "ground of rejection is simply inadequate on its face . . . [when] the

cited references do not support each limitation of [the] claim." *In re Thrift*, 63 USPQ2d 2002, 2008 (Fed. Cir. 2002).

Neither Brown nor Sheldon adds anything to cure the fatal deficiency in each of Keivits and Nakahara. Thus, the cited references do not disclose or suggest the present invention at all, and, on the contrary, they teach away from the presently claimed invention by disclosing clearly different amplification conditions. Accordingly, withdrawal of the the rejections under 35 USC 103(a) appears to be in order.

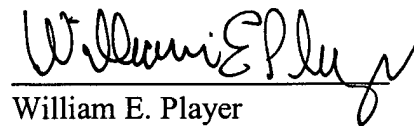
Claims 4 and 5 were not rejected over the prior art and, so, are implicitly allowable over the prior art. Present claims 21 and 22 correspond to claims 4 and 5, rewritten to overcome the rejection under §112, ¶2, as explained above. Accordingly, present claims 21 and 22 are allowable.

Favorable action is requested.

Respectfully submitted,

JACOBSON HOLMAN PLLC

By


William E. Player
Reg. No. 31,409

400 Seventh Street, NW
The Jenifer Building
Washington, D.C. 20004
Tel. (202) 638-6666
Fax (202) 393-5350
Date: February 23, 2005
WEP/bad
R:\rthomas\2005\February\P66351-amd(draft2).wpd